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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,704	02/06/2004	Joseph L. Ungari	005127.00266	7368
22910	7590	10/17/2006	EXAMINER	
BANNER & WITCOFF, LTD. 28 STATE STREET 28th FLOOR BOSTON, MA 02109-9601				PATTERSON, MARIE D
		ART UNIT		PAPER NUMBER
				3728

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

NT

Office Action Summary	Application No.	Applicant(s)	
	10/774,704	UNGARI, JOSEPH L.	
	Examiner Marie Patterson	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 August 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 1-3, 5-19, 21-31, and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parihar et al. (2004/0002665) in view of Sasaki (5230249) or Lakic (6014823).

Parihar shows all of the limitations substantially as claimed including the following (see figure 5 and figure 13A): a sole structure (514), an upper (500 secured to the sole structure), at least one reservoir of magneto-rheological fluid (504), and a magnet assembly (510) proximate each reservoir, wherein a magnetic field produced by the magnet assembly transforms the magneto-rheological fluid from a fluid state to a near-solid state (see paragraphs [0116-0118]), the magnet assembly comprises a plurality of permanent magnets (510), when the article of footwear is in a first condition the permanent magnets are spaced apart from the reservoir (uncompressed state, i.e. when the user's foot is not in the shoe) and the magneto-rheological fluid is in a fluid state, and when the article of footwear is in a second condition (with the user's foot in the shoe) the permanent magnets are proximate the reservoir and create a magnetic field within the reservoir and transforms the magneto-rheological fluid into a near-solid state, the magnet assembly comprising a plurality of electromagnets (510), a load cell (518) configured to activate the electromagnets upon detection of a force from a user's foot,

the load cell is positioned in the sole structure (see figure 5), a power source (512) connected to the electromagnets, the power source comprises a battery (512), the magnet assembly comprising a plurality of magnets (510) on a first side of a reservoir and a plurality of magnets (510) on an opposed second side of the reservoir (see figure 5), the magneto-rheological fluid comprises particles suspended in oil (see paragraph [0011]), the magneto-rheological fluid comprises iron molecules suspended in silicon (MR fluids known to contain silicon or oil), the reservoir of magneto-rheological fluid is located in compressible support element (504) secured to a bottom surface of the sole structure (bottom of insole). Parihar does not disclose the reservoir of fluid being located in the upper or sidewall of the upper, however Parihar does teach providing a reservoir surrounding the lower leg of a wearer (see figure 13A). Either Sasaki or Lalic teaches providing fluid filled reservoirs in both the upper and the sole of footwear to provide optimum support for the wearers' foot. It would have been obvious to extend the reservoirs into the upper in addition to the sole as taught by either Sasaki or Lalic in the shoe of Parihar to increase support of the entire foot.

3. Claims 4, 20, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 3, 19, and 31 above, and further in view of Demon (5813142).

Parihar as modified above shows a shoe substantially as claimed except for the footwear transforming from one state to another upon detection of a force from a user's foot. Demon teaches that the support of a shoe can be adjusted based upon the force felt upon the shoe by the user's foot during use, by using sensors to send signals to an

internal computer to adjust the rigidity of the supports. Therefore, it would have been obvious to place sensors in the support of teh the references as applied to claims 3, 19, and 31 above to detect when more support was needed to activate the magnets to give more support tot the users' foot during use as taught by Demon.

Response to Arguments

4. Applicant's arguments filed 8/16/06 have been fully considered but they are not persuasive. .

In response to applicants' arguments directed towards specific types of supports and how such supporting means function is not persuasive. The fact remains that all references are directed towards footwear with reservoirs which are filled with a fluid for supporting the foot. The modifying references to Sasaki and Lajic have been provided only to teach that it is known to provide reservoirs in the upper of footwear in addition to the sole for increase support of the foot. This teaching is applicable to all footwear having reservoirs for support including that of Parihar. Also it is noted that Parihar does shown/suggest that the supporting reservoir is capable of being used to surround the lower leg as shown in figure 13A.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (572)273-8300 (**FORMAL FAXES ONLY**). Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Art Unit: 3728

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson
Primary Examiner
Art Unit 3728